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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/512,033

09/15/2005

Scott G. Safar

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7590

08/29/2008

VYSIS, INC
PATENT DEPARTMENT
1300 E TOUHY AVENUE
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EXAMINER

REIFSNYDER, DAVID A

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

08/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/512,033	Applicant(s) SAFAR ET AL.	
	Examiner David A. Reifsnnyder	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Note: Due to this application having two different claims 4's, the numbering of claims is not in accordance with 37 CFR 1.126. In addition to responding to the following restriction requirement, the applicant should renumber his claims from the second claim number 4 on so as to be in accordance with 37 CFR 1.126. Furthermore, in the following restriction requirement the applicant's second claim number 4 is considered to be claim number 5 and the applicants original claim numbers 5-16 are considered to be claims 6-17, respectively.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I claims 1, 15,16 and 17, drawn to a method of separating magnetic particles suspended in a fluid wherein, the magnetic particles may be bound to a target of interest such as a nucleic acid.

Group II, claims 2-4, drawn to an apparatus for isolating magnetic particles from a fluid comprising an array of magnets.

Group III, claims 5-7, drawn to an apparatus for isolating a nucleic acid from a fluid comprising first and second process paths.

Group IV, claims 8-10, drawn to an apparatus for isolating an item of interest in a sample comprising a vertically oriented magnet and holder adapted to hold a container having the sample near the magnet.

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Group V, claim 11, drawn to an automated pipettor utilizing first and second disposable pipette tips.

Group VI, claims 12-14, drawn to an apparatus comprising a holder for a container array, a magnet array for capturing magnetic particles, and a bias magnet spanning the container array.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Each Group has a special technical feature that is not in another Group.

The Special Technical Features of Group I not in another Group is positioning a container which contains a fluid having magnetic particles in a first position relative to a magnet so that the magnet exerts a magnetic field on the magnetic particles and the magnetic particles isolate in a first isolation zone away from a first aspiration zone; actuating a pipettor so as to aspirate a quantity of fluid from the first aspiration zone of the container; repositioning the magnet and/or container in a second position separated from the pipettor, whereby in the second position the magnet applies a magnetic field to the magnetic particles to isolate the magnetic particles in a second isolation zone away from a second aspiration zone; and actuating the pipettor to aspirate the fluid from the second aspiration zone.

The Special Technical Feature of Group II not in another Group is that the array of magnets is positioned adjacent to the array of magnets such that each container is adjacent to only one magnet.

The Special Technical Feature of Group III not in another Group is the second process path being positioned vertically below the first process path.

The Special Technical Feature of Group IV not in another Group is the vertically oriented magnet and a holder adapted to hold a container having a sample near the magnet.

The Special Technical Feature of Group V not in another Group is the automated pipettor utilizing first and second pipette tips, comprising; a container adapted to store the first disposable pipette tip from the second disposable pipette tip.

The Special Technical Feature of Group VI not in another Group is the bias magnet spanning a container array to provide an effective magnetic field originating at opposite ends of the container array.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Reifsnnyder whose telephone number is (571) 272-1145. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David A Reifsnyder/
Primary Examiner, Art Unit 1797